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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/535,005	03/23/2000	William S. Bess	PD A0000259-03EJF	1060

29668 7590 11/22/2002

PFIZER, INC.  
201 TABOR ROAD  
MORRIS PLAINS, NJ 07950

EXAMINER
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PESELEV, ELLI

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 11/22/2002

24

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/535,005

Applicant(s)

BEES ET AL.

Examiner

Elli Peselev

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-13, 20 and 25-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-19, 21-24 and 27-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

Claims 1-13, 20, 25-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

Applicant's arguments filed October 18, 2002 have been fully considered but they are not persuasive.

Note that in amendment filed September 1, 2001, applicants have elected the species of claim 22 which reads on the water soluble polymer being pullulan, the pharmaceutically active agent being dextromethorphan and the taste masking agent being a sulfonated polymer ion exchange resin. However, in the newly amended claim 1, the taste masking agent has been limited to magnesium trisilicate, acrylic copolymers, cellulose ethers and ethyl cellulose i.e. the taste masking agent has been limited to the non-elected species.

Claims 14-19, 21-24 and 27-31 have been examined only insofar as the elected species is concerned.

Claims 14-19, 21-24 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no antecedent basis in claim 1 for the taste masking agent being an ion exchange resin as set forth in claims 14-19, 21-24 and 27.

Claims 14-19, 21-24 and 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eichman (U.S. Patent No. 5,980,882) in combination with Ozaki et al (U.S. Patent No. 5,411,945).

Eichman discloses a dextromethorphan drug-resin complex having a ratio of 2:1 (column 17, lines 4-11). Eichman further discloses that the drug-resin complex can be coated with any film-forming material (column 12, lines 62-68 and column 13, 1-30) but does not disclose a film-forming material being pullulan. However, since film-forming properties of pullulan were well known in the art at the time the instant invention was made as disclosed by Ozaki et al (column 1, lines 18-25), a person having ordinary skill in the art at the time the instant invention was made would have been motivated to use pullulan as a film-forming material in a drug-resin complex disclosed by Eichman because the results obtained by such a combination would have been expected.

Applicant's arguments filed October 18, 2002 have been fully considered but they are not persuasive insofar as the above rejection relates to the claims.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elli Peselev whose telephone number is 703-308-4616. The examiner can normally be reached on weekdays 8.30 a.m. - 5.00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 703-308-4624. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Elli Peslev  
November 21, 2002

  
**ELLI PESELEV  
PRIMARY EXAMINER  
GROUP 1800**